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21

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,740	12/10/2003	Thao D. Hovanky	COVI:004	6547

7590 12/28/2005  
O'KEEFE, EGAN & PETERMAN, L.L.P.  
Building C, Suite 200  
1101 Capital of Texas Highway South  
Austin, TX 78746

EXAMINER
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BEN, LOHA

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/732,740

Applicant(s)

HOVANKY, THAO D.

Examiner

Loha Ben

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-60 and 64-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-41, 64-73 and 79-90 is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 11, 14-18, 21, 22, 42-45, 52-54, 56 and 57 is/are rejected.
- 7) ☒ Claim(s) 4-9, 12, 13, 19, 20, 23, 24, 46-51, 55 and 58-60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

**Remark:** The present application has been transferred from Examiner Mack to Examiner Ben.

#### ***Response to Amendment***

The Amendment dated October 17, 2005 in response to the previous Office action issued by Examiner Mack has been noted with appreciation. However, after a new search, new art has been found that can be used against some of the claims that have been amended. Any inconvenience this may have caused Applicant, is sincerely regretted.

#### ***Minor Informalities Noted in the Claims***

In claims **10 and 56**: line 1, before "comprises", -- component -- should be inserted.

In claim 20: line 2, "component" should be deleted.

In claim 25: bottom line, "component" should be deleted.

In claim 27: line 2, between "housing" and ";", ",", should be deleted; and line 4, "component" should be deleted.

In claim 28: line 2, "component" should be deleted.

In claim 29: line 3, "component" should be deleted.

In claim 35: line 3, before "and", "component" should be deleted.

In claim 37: line 3, "component" should be deleted, and after "lens"(second occurrence), -- . --(period) should be inserted.

In claim 42: line 2, after "block", -- assembly -- should be inserted.

In claim 45: line 3, after "lens"(second occurrence), -- component – should be inserted; and line 5, after "block", -- assembly – should be inserted.

In claim 49: line 1, after "block"(second occurrence), -- assembly – should be inserted.

In claims 51 and 76: line 2, "or" should be – and --.

In claim 52: line 9 (space not counted), after "lens", -- component – should be inserted.

In claim 60: line 5, "assembly" should be replaced with – component --.

In claims 70 and 71: line 2, "component" should be deleted.

In claim 79: lines 9 and 12 (space not counted), after "moving lens", -- component – should be inserted.

In claim 84: bottom line, "assembly" should be replaced with – component --.

In claim 85: line 7 (space not counted), "operations" should be – operation --.

In claim 88: line 9 (space not counted), "operations" should be – operation --.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

In claim 74: The stationary coil component, and the ferromagnetic fluid bearings are narratively recited in that their relative positions with respect to the rest of the limitations are not seen.

In claim 75: The stationary coil component is narratively recited (see claim 74 above). What is the relationship between the moving lens component recited and the at least two actuatable lens assemblies? Further, lines 1 and 7 appear to generate an inconsistency, because, on line 1, the existence of one actuatable lens assembly is possible, whereas on line 7, the block assembly must have at least two actuatable lens assemblies.

In claim 77: The stationary coil component is narratively recited (see claims 74 and 75 above).

Claims 76, 78 depending from claims 75 and 77, respectively, inherit the indefiniteness thereof.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 10, 11, 14-18, 21, 22, 42-45, 52-54, 56 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Sekine et al.

Regarding independent claims 1, 14, 42 and 52, reference is made to Figs. 9A, 9B and 10, and the accompanying texts, in which lens 31 and magnet 51 are seen mounted on movable portion 43, with the coil 46 mounted on fixed portion 42 and wound around the lens 31.

For claim 2, see numeral 51 of Fig. 10.

For claim 3, as now broadly recited, the fixed portion 42 and the movable portion 43 of the patent can be considered as the lens guidance mechanism of claim 3.

For claim 10, see column 5, lines 11-19.

For claim 11, the limitation recited is inherent element of the device of the patent.

For claims 15-18, 21 and 22, reference is made to column 5, lines 11 to column 6, line 22. Reasons for the rejection of these claims are similar to those indicated above with respect to claims 2, 3, 10 and 11.

For claims 43-45, 53, 54, 56 and 57, reasons for the rejection of the claims are similar to those given above.

Claims 1-3, 10, 11, 14-18, 21, 22, 42-45, 52-54, 56 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoneyama et al.

As now presented, the above indicated claims read on Figs. 1-3 and the accompanying texts of Yoneyama et al, in which: the moving magnet component is element 6; the stationary coil component is represented by numeral 8; and the moving lens component is element 2.

**Specifically:** For the permanent magnet of claims 2, 15, 43 and 53, though element 6 of the patent is not disclosed as being permanent magnet, it is noted that it is attached to a yoke 7; and therefore, it is a permanent magnet.

For the guidance mechanism of claims 3, 17, 45 and 54 that is coupled to the moving lens (or moving lens component), reference is made to magnetic members 9 and 10.

For the focus lens or zoom lens characteristic of the moving lens (or moving lens component) of claims 10, 21, 44 and 56, the consideration being that the lens driving

Art Unit: 2873

device of the patent is the device for a camera that is mounted on a cellular phone, which inherently has focusing and zooming operations. See column 1, lines 7-58.

### **Allowable Subject Matter**

Claims 25-41, 64-73 and 79-90 are allowable.

Claims 4-9, 12, 13, 19, 20, 23, 24, 46-51, 55 and 58-60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 74, 75 and 77 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

### **Communication**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Loha Ben whose telephone number is (571) 272-2323. The examiner can normally be reached on Monday to Saturday, generally between 12:00 noon to 8:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack, can be reached on Monday to Friday, at (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2873

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 26, 2005



**Loha Ben**  
**Primary Examiner**